

Appl. No. 10/026,140
Amdt. dated February 9, 2005
Reply to Office Action of January 26, 2005

REMARKS

The Invention.

The present invention provides a novel β -glucosidase nucleic acid sequence, designated *bgl5*, and the corresponding BGL5 amino acid sequence. The presently claimed invention also provides expression vectors and host cells comprising a nucleic acid sequence encoding BGL5, recombinant BGL5 proteins and methods for producing the same.

Status of the Application.

Claims 2-17, 19-20, 22-24 and 26 are pending in the application. Claims 2 and 22 have been amended herein. Claim 2 has been amended to correct a subparagraph designation. Claim 22 has been amended to clarify what Applicants believe is the metes and bounds of the invention. Support for these amendments may be found throughout the specification as filed. No new matter is introduced by these amendments and their entry is respectfully requested.

35 U.S.C. §112, first paragraph.

Claim 22 stands rejected under 35 USC §112, first paragraph as failing to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Specifically, the Examiner asserts that the claim is so broad as to encompass any host cell comprising any or all polynucleotides simply labeled as "bgl 5 gene" (see page 2 of the Office Action). In addition, the Examiner asserts that the claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention. Applicants respectfully traverse.

Although Applicants must respectfully disagree with the Examiner's argument and rationale, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments, Applicants have amended Claim 22 to more clearly describe what the Applicants consider the invention.

Applicants are not required to describe in detail each and every embodiment of the presently claimed invention. Indeed, "a patent need not teach, and preferably omits what

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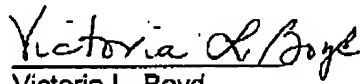
Is well known in the art" (See e.g., *In re Buchner*, 929 F.2d 660, 661; MPEP 2164.01). The Specification teaches how to modify the nucleotide sequences encoding the beta-glucosidase (see page 20, line 27-37), how to insert the nucleotide sequences (see page 29, line 16 *et seq.*) and how to assay its expression and/or production (see page 31, line 17 *et seq.*). In addition, the Applicants specifically contemplated "a decrease or elimination in expression" of a beta-glucosidase (see page 13, lines 5-9 and page 31, line 12-16).

As noted previously, Applicants have provided methods of preparing and using the polynucleotides. See page 18 *et seq.* This would not involve undue experimentation, but would be routine to one of ordinary skill in the art. Applicants assert that they have provided written description of their invention and have provided ample exemplification, given the state of the art, to allow one of skill in the art to make and use the invention without undue experimentation. Applicants assert that the claim is enabled. Thus, Applicants respectfully request that this rejection be withdrawn.

CONCLUSION

In light of the above amendments, as well as the remarks, the Applicants believe the pending claims are in condition for allowance and issuance of a formal Notice of Allowance at an early date is respectfully requested. If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (650) 846-7615.

Respectfully submitted,


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